IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number:	10/741,799
Filing Date:	12/19/2003
Applicant(s):	Thomas E. Creamer, et al.
Entitled:	SERVICE DELIVERY INSTRUCTION PROCESSING SERVICE
Examiner:	Rasha S. Al-Aubaidi
Group Art Unit:	2614
Attorney Docket No.:	BOC9-2003-0113US1 (1082-017U)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal filed

March 11, 2009. As this Appeal Brief has been timely filed within the shortened statutory period

of two months from the date of the Notice of Appeal, no extension of time under 37 C.F.R. §

1.136 is required. Notwithstanding, please charge any shortage in fees due under 37 C.F.R. §§

1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to

Deposit Account 50-3829, and please credit any excess fees to such deposit account.

Date: May 11, 2009   Respectfully submitted,

                                      /Steven M. Greenberg/_____
                                      Steven M. Greenberg, Registration No. 44,725
                                      Customer Number 46322

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 11, 2009, wherein Appellants appeal from the Examiner's rejection of claims 1 through 13.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on December 19, 2003, at Reel 014838, Frame 0558.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1 through 13 are pending in this Application and have been three times rejected. It is from the multiple rejections of claims 1 through 13 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

Claims 1, 7 and 8 were amended in an amendment dated January 10, 2008 (the "Amendment").

V. SUMMARY OF CLAIMED SUBJECT MATTER

By reference to paragraphs [0021] through [0023] of Appellants' published specification, Appellant has invented a method, system and apparatus for managing delivery instructions through a PSTN. In accordance with Appellants' invention, a customer can contact the delivery service over a PSTN to manage the delivery of the goods or services. When attempting to place the call, the call can be intercepted within the PSTN and identifying information for the calling customer can be extracted from a database within the PSTN. The identifying information can be provided over a data communications network to the delivery service. Using the identifying information received over the data communications network, the delivery service can retrieve information regarding the delivery of goods or services and also, the delivery service can instantly authenticate the calling customer based upon the identifying information.

As the call from the customer is completed over the PSTN, the identifying information, and in particular, the-retrieved information, can be correlated to the completed call such that an operator or an automated call center in the delivery service can access the information through

the data communications network while processing the completed call from the customer. Significantly, as the identifying information can be resolved externally to the service provider from a trusted source within the PSTN, the delivery service can manage the delivery of the goods or services without first prompting the customer for identifying information.

With specific reference to claim 1, a method for managing delivery service instructions can be provided. (Par. [0033]) The method can include prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service (Par. [0035]) without first prompting the customer for identifying information. (Par. [0034]) The method further can include managing the delivery instructions without accessing customer information derived through the phone call. (Par. [0035])

With specific reference to claim 7, a system for managing subscriber services can be provided. (Par. [0024]) The system can include a delivery service instructions management system configured to manage delivery service instructions based upon identifying information associated with customers associated with the delivery service instructions. (Par. [0023]) The system also can include customers calling a delivery service instructions management system over a public switched telephone network (PSTN) to manage respective delivery instructions corresponding to previously ordered goods or services. (Par. [0026]) Finally, the system can include logic disposed within the PSTN, coupled to the delivery service instructions management system over a data communications network, (Par. [0025]) and configured to obtain the identifying information in the PSTN (Par. [0025]) and to provide the obtained identifying

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information to the delivery service instructions management system through the data communications network. (Par. [0025])

With specific reference to claim 8, a machine readable storage is recited to embody a computer program for managing delivery service instructions. (Par. [0033]) The computer program includes a routine set of instructions which when executed by a machine causes the machine to perform operations including prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service (Par. [0035]) without first prompting the customer for identifying information. (Par. [0034]) The operations further can include managing the delivery instructions without accessing customer information derived through the phone call. (Par. [0035])

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 8 through 13 have been rejected under 35 U.S.C. § 112, first paragraph.

Claims 1 through 6 and 8 through 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2008/0294977 by Friedman et al. (Friedman).

Claim 7 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Friedman.

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 8 THROUGH 13 UNDER 35 U.S.C. § 112

The specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation.[1] Additionally, the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure.[2] However, enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive.[3] The factual inquiry for determining whether a specification provides sufficient written description for the claimed invention is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.[4] An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.[5]

Examiner on page 3 of the Non-Final Office Action states that the term "machine readable storage having stored thereon a computer program" as recited in claim 9 is not described in Applicants' specification. In response, Applicants' direct Examiner to paragraphs [0039] through [0041] of Applicants' published specification in which it is stated:

> [0039] The present invention can be realized in hardware, software, or a combination of hardware and software. An implementation of the method and system of the present invention can be realized in a centralized fashion in one computer system, or in a distributed fashion where

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[1] Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365 (Fed. Cir. 1997)
[2] Id.
[3] Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384 (Fed. Cir. 1986).
[4] Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).
[5] Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997)

different elements are spread across several interconnected computer systems. Any kind of computer system, or other apparatus adapted for carrying out the methods described herein, is suited to perform the functions described herein.

[0040] A typical combination of hardware and software could be a general purpose computer system with a computer program that, when being loaded and executed, controls the computer system such that it carries out the methods described herein. The present invention can also be embedded in a computer program product, which comprises all the features enabling the implementation of the methods described herein, and which, when loaded in a computer system is able to carry out these methods.

[0041] Computer program or application in the present context means any expression, in any language, code or notation, of a set of instructions intended to cause an information processing capability to perform a particular function either directly or after either or both of the following a) conversion to another language, code or notation; b) reproduction in a different material form. Significantly, this invention can be embodied in other specific forms without departing from the spirit or essential attributes thereof, and accordingly, reference should be had to the following claims, rather than to the foregoing specification, as indicating the scope of the invention..

In that paragraphs [0039] through [0041] expressly teach the use of a computer program product in which the invention can be embedded. Those paragraphs further teach that the computer program can include instructions "intended to cause a system having an information processing capability to perform a particular function". Those paragraphs yet further teach that the computer program, when executed" controls the computer system such that it carries out the methods described as part of the invention. It is inherent to the use of computer programs that the instructions are stored on a medium that can be read by a computer system to do so and one of skill in the art at the time of the invention would know as much without any experimentation required. In fact, Applicants are unaware of any other way in which a computer program can execute in a computer system without having instructions first loaded in some machine readable medium. As such, the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as now claimed.

THE REJECTION OF CLAIMS 1 THROUGH 6 AND 8 THROUGH 13 UNDER 35 U.S.C. § 103

Examiner bases the entirety of all rejections under 35 U.S.C. § 103(a) upon Friedman.

Friedman enjoys a filing date of **March 7, 2008** and a publication date of **November 27, 2008**.

Both postdate Appellants' filing date of **December 19, 2003**. Friedman, however, claims priority to

U.S. Patent Application Ser. No. 09/420,434 as a *continuation-in-part (CIP)* thereof. Further,

Friedman claims priority to U.S. Patent Application Ser. No. 60/405,510--a provisional patent

application. The particular portion of Friedman relied upon in rejecting each of Applicants'

independent claims is paragraphs [0144] and [0145]. For the convenience of the Honorable Board,

paragraphs [0144] and [0145] are reproduced herein in its entirety:

> [0144]   in another alternative embodiment, the system 250 is further connected to a traditional
> circuit-switched telephone network 296 via an Interactive Voice Response (IVR) System 285
> which may be part of the system 250 or part of the eCommerce vendors network facilities. As
> shown in FIGS. 12 and 13, a Public Switched Telephone Network (PSTN) central office 294 is
> operatively coupled to terminating apparatus 292A-B and IVR system 285. Although only one
> central office 294 is illustrated, it will be obvious to those skilled in the arts that multiple central
> offices may be operatively interconnected by, for example, a toll network implemented as a
> traditional PSTN network including routers, trunk lines, fiber optic cables, etc. Connected to
> central office 294 is a traditional telephone terminating apparatus 292A, which may be located at a
> shopper's premises, and terminating apparatus 292B, which may be located at a vendor's premises.
> Terminating apparatus 292A-B may be implemented with either a digital or analog telephone or
> any other apparatus capable of receiving a circuit switched call, such as modems, facsimile
> machines, etc., such apparatus being referred to collectively hereinafter as a terminating apparatus,
> whether the network actually terminates. Further, the PSTN network may be implemented as
> either an integrated services digital network (ISDN) or a plain old telephone service (POTS)
> network. In addition to or in place of IVR system 285 a traditional automatic call center (ACD)
> system may be coupled to the PSTN network. An automatic call center (ACD) system suitable for
> use with the present invention is any of the Galaxy family of call center products commercially
> available from Rockwell International, Irvine, Calif.

> [0145]   In an alternative embodiment to IVR system 285, network user may establish a real-time
> point-to-point communication link with an actual sales assistant at an automatic call center linked
> to either system 250 or the eCommerce web server 212 over a packet-switched data network using
> Internet telephony software and/or hardware. In such an embodiment live online communication
> between network users and sales associates representing the eCommerce vendor may be
> established over the Internet 205. Using this service, network user would be able to interact more
> directly with the eCommerce vendor, having their orders for products and cards and
> customizations to selected cards performed at the same time products and services are ordered.
> Such comprehensive support would ensure that questions about specific products or cards are
> answered properly and allows network user to call in changes or additions to their card order,
> whether placed originally over the telephone, on-line through a web server, or other by other
> means.

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Importantly, the disclosure of paragraphs [0144] and [0145] of Friedman as it relates to

> Such comprehensive support would ensure that questions about specific products or cards are
> answered properly and allows network user to call in changes or additions to their card order,
> whether placed originally over the telephone, on-line through a web server, or other by other
> means.

cannot be found in U.S. Patent Application Ser. No. 09/420,434. In fact, the notion of an IVR

system--indeed the term IVR--is wholly absent in U.S. Patent Application Ser. No. 09/420,434. As

such, the teachings of paragraphs [0144] and [0145] are to be considered "new matter" with respect

to Friedman and cannot enjoy the priority date of U.S. Patent Application Ser. No. 09/420,434. In

particular, under M.P.E.P. 2136.02,

> When a U.S. patent, a U.S. patent application publication, or an international application
> publication is used to reject claims under 35 U.S.C. 102(e), the disclosure relied on in the rejection
> must be present in the issued patent or application publication. It is the earliest effective U.S. filing
> date ... of the U.S. patent or application publication being relied on as the critical reference date
> and subject matter not included in the patent or application publication itself can only be used
> when that subject matter becomes public.

Thus, the portion relied upon by Examiner in Friedman enjoys an earliest filing date with respect to

U.S. Patent Application Ser. No. 09/420,434 of **March 7, 2008**--more than four (4) years

subsequent to Appellants' priority date.

With respect to U.S. Patent Application Ser. No. 60/405,510--a provisional patent

application, the notion of an IVR system is provided only on pages 35 and 36 of the provisional

patent application. For the convenience of the Honorable Board, the entirety of the two paragraphs

of the provisional patent application discussing an IVR system in substance is provided verbatim as

follows:

> In another alternative embodiment, the system 250 is further connected to a traditional circuit-
> switched telephone network 296 via an Interactive Voice Response (IVR) System 285 which may
> be part of the system 250 or part of the eCommerce vendors network facilities. As shown in Fig.
> 12 and 13, a Public Switched Telephone Network (PSTN) central office 294 is operatively
> coupled to terminating apparatus 292A-B and IVR system 285. Although only one central office

294 is illustrated, it will be obvious to those skilled in the arts that multiple central offices may be operatively interconnected by, for example, a toll network implemented as a traditional PSTN network including routers, trunk lines, fiber optic cables, etc. Connected to central office 294 is a traditional telephone terminating apparatus 292A, which may be located at a shopper's premises, and terminating apparatus 292B, which may be located at a vendor's premises. Terminating apparatus 292A-B may be implemented with either a digital or analog telephone or any other apparatus capable of receiving a circuit switched call, such as modems, facsimile machines, etc., such apparatus being referred to collectively hereinafter as a terminating apparatus, whether the network actually terminates. Further, the PSTN network may be implemented as either an integrated services digital network (ISDN) or a plain old telephone service (POTS) network. In addition to or in place of IVR system 285 a traditional automatic call center (ACD) system may be coupled to the PSTN network. An automatic call center (ACD) system suitable for use with the present invention is any of the Galaxy family of call center products commercially available from Rockwell International, Irvine, CA

In an alternative embodiment to IVR system 285, network user may establish a real-time point-to-point communication link with an actual sales assistant at an automatic call center linked to either system 250 or the eCommerce web server 212 over a packet-switched data network using Internet telephony software and/or hardware. In such an embodiment live online communication between network users and sales associates representing the eCommerce vendor may be established over the Internet 205. Using this service, network user would be able to interact more directly with the eCommerce vendor, having their orders for products and cards and customizations to selected cards performed at the same time products and services are ordered. Such comprehensive support would ensure that questions about specific products or cards are answered properly and allows network user to call in changes or additions to their card order, whether placed originally over the telephone, on-line through a web server, or other by other means.

Thus, the only teachings directed to an IVR system in the provisional patent application provide that a sales assistant can interact with a customer telephonically by way Internet telephony from within a call center. No other teachings as a review of the foregoing passages will reveal, are provided in connection with an IVR system.

Yet, Examiner relies upon an alleged teaching in Friedman of a "user can be prompted to enter appropriate information [using an IVR system] (see page 4 of the Non-Final Office Action dated December 11, 2008). In that the concept of prompting a customer within an IVR system is wholly absent in U.S. Patent Application Ser. No. 09/420,434 and U.S. Patent Application Ser. No. 60/405,510--the provisional patent application, the earliest effective filing date of Friedman with respect to these alleged teachings is March 7, 2008--again more than 4 years subsequent to the priority date of Applicants' invention.

In that the teachings relied upon by Examiner in Friedman postdate Applicants' invention, Friedman is NOT prior art under 35 U.S.C. § 102(e) for purposes of 35 U.S.C. § 103(a). Specifically, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from a non-provisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application for subject matter that is disclosed in the provisional application.[6] As such, Examiner cannot establish a prima facie case of anticipation based upon the Friedman reference. Appellants, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103(a).

THE REJECTION OF CLAIMS 1 THROUGH 13 UNDER 35 U.S.C. § 102

Examiner relies upon Friedman as the sole foundation for the rejection of claim 7. Again, Friedman for the portions of which Friedman has been recited, is NOT prior art to Appellants' patent application as those portions of Friedman appear only in Friedman and not in the content or teachings of the applications to which Friedman claims priority.

In that the teachings relied upon by Examiner in Friedman postdate Applicants' invention, Friedman is NOT prior art under 35 U.S.C. § 102(e). Specifically, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from a non-provisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application for subject matter that is disclosed in the provisional application.[7] As such, Examiner cannot establish a prima facie case of anticipation based upon the Friedman reference. Appellants, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 102(e).

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[6] See M.P.E.P. 901.04.
[7] See M.P.E.P. 901.04.

Date: May 11, 2009   Respectfully submitted,

                              /Steven M. Greenberg/
                              Steven M. Greenberg
                              Registration No. 44,725
                              Customer Number 46321

VIII. CLAIMS APPENDIX

1.   (Previously Amended)   A method for managing delivery service instructions, the method comprising:

prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,

managing said delivery instructions without accessing customer information derived through said phone call.

2.   (Original)   The method of claim 1, wherein said prompting step comprises the step of prompting a customer through an established telephone call to change said delivery instructions without first prompting said customer for identifying information.

3.   (Original)   The method of claim 2, wherein said managing step comprises the step of changing said delivery instructions without accessing customer information derived through said phone call.

4.   (Original)   The method of claim 3, wherein said changing step comprises the step of changing at least one of an established delivery address, directions to said established delivery address, a contact phone number, and a procedure to be performed either before, during or after performing a delivery according to said delivery instructions.

5.   (Original)   The method of claim 1, further comprising the step of transferring said phone call to a customer service representative responsive to a request for live help by said customer.

6.   (Original)   The method of claim 1, further comprising the step of charging said customer for managing said delivery instructions.

7.   (Previously Amended)   A system for managing subscriber services, the system comprising:

a delivery service instructions management system configured to manage delivery service instructions based upon identifying information associated with customers associated with said delivery service instructions;

a plurality of customers calling a delivery service instructions management system over a public switched telephone network (PSTN) to manage respective delivery instructions corresponding to previously ordered goods or services; and,

logic disposed within said PSTN, coupled to said delivery service instructions management system over a data communications network, and configured to obtain said identifying information in said PSTN and to provide said obtained identifying information to said delivery service instructions management system through said data communications network.

8.   (Previously Amended)   A machine readable storage having stored thereon a computer program for managing subscriber services, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of:

prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,

managing said delivery instructions without accessing customer information derived through said phone call.

9.   (Original)   The machine readable storage of claim 8, wherein said prompting step comprises the step of prompting a customer through an established telephone call to change said delivery instructions without first prompting said customer for identifying information;

10.   (Original)   The machine readable storage of claim 9, wherein said managing step comprises the step of changing said delivery instructions without accessing customer information derived through said phone call.

11.   (Original)   The machine readable storage of claim 10, wherein said changing step comprises the step of changing at least one of an established delivery address, directions to said established delivery address, a contact phone number, and a procedure to be performed either before, during or after performing a delivery according to said delivery instructions.

12.   (Original)   The machine readable storage of claim 8, further comprising the step of transferring said phone call to a customer service representative responsive to a request for live help by said customer.

13.   (Original)   The machine readable storage of claim 8, further comprising the step of charging said customer for managing said delivery instructions.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.